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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,654	02/16/2001	George Brookner	770P009677-US (PAR)	2968
7590 Kenyon & Kenyon LLP 1500 K Street, NW Washington, DC 20005-1257			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 06/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/785,654

Applicant(s)

BROOKNER ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 36-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 and 36-42 are drawn to a postage meter, classified in class 705, subclass 60.
  - II. Claim 43 is drawn to method for using an adapter, class 361, subclass 686.
  
2. Newly submitted claim 43 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as postage metering, while invention II has separate utility such as a chip card reader See MPEP. 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 43 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP. 821.03. Applicant is respectfully requested to

cancel the non-elected claims in response to this office action.

### ***Status of Claims***

3. Claims 1-13 and 36-42 have been examined.

### ***Response to Amendments/Arguments***

4. Applicant is of the opinion that the prior art of Graves does not teach "a communication interface *for* assigning said device *to operate* in an initial application environment" (emphasis added). The Examiner respectfully disagrees.

Initially, the Examiner would like to point out that the language that Applicant considers lacking from Graves is intended use (e.g. "for providing", "information assigning said device to operate in an initial application environment", "so as to assign") and it has been held that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Similarly, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of

structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, as Graves teaches Applicant's claimed "communication interface" (figure 1), and the interface can be used for changing information, such as information that assigns a postage meter for operating in an initial operating environment (column 7, lines 47-53) it is sufficient in terms of art. Claim 36 also recites functional language (e.g. "to store", "to provide").

Claim 36 has been amended to further describe information stored in memory. However, this is representative of non-functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). Nonetheless, as Graves teaches storing in device memory the name and address of a post office that supervises the device (column 7, lines 47-53; column 12, lines 10-50), the prior art teaches information "assigning the device to one of an open postal system, closed postal system and a data center".

Claim 38 recites "when the device is to be used in a new application environment". Regarding conditional or optional language the MPEP is clear, language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106, II, C; *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)).

The Examiner maintains the 112 second paragraph rejection to claims 5, 6 and 42 because it is unclear to one of ordinary skill whether or not the adapter is connected to the device and whether or not the connector is connected to said device.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 6, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It has been held that an apparatus claim whose features are described in terms of actions that may or may not be done is indefinite and does not distinguish the claim from the prior art. Claim 5 is directed to a device with an

adapter "*for connecting*" to said device, said adapter comprises an electrical connector "*configured to* said device" and an interface "so that said device *can be identified*" (emphasis added). Hence, as the features of claim 5 are recited in terms of "possibility", the claim is indefinite.

Claims 6 and 42 are also rejected as they depend from claim 5.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims rejected under 35 U.S.C. 102(b) as being clearly anticipated by Graves et al., U.S. Patent No. 5,309,363.

As per claims 1-9 and 36-42, Graves et al. teach a (virtual) device (figures 1 and 4b; column 8, lines 25-63) comprising:

- a first storage for storing funds (abstract; figure 1-item 160 and figure 4)

- an internally (e.g. circuitry) stored identifier, digital data or string (e.g. meter number) (abstract; figure 1- item 170 and figure 4; column 4, lines 1-6 and 43-47; column/line 6/65-7/17)
- a second storage for storing information and a communications interface for changing said information (figure 1, item 195; column 4, lines 38-53; column/line 7/40-8/10; column 12, lines 10-50)
- a second communications interface to provide the stored identifier to an external system (column 4, lines 43-47)
- an interface that supports communication with RS-232, IEEE 488, USB, TCP/IP, SCSI, Infrared, RF, net appliance protocol, PC, or PC bus protocols (figure 1)
- an application environment that is a closed postal system (figures 1 and 4b)

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



10. Claims 10-13 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al., U.S. Patent No. 5,309,363.

As per claim 10, open postal systems are old and well known therefore, it would have been obvious to one of ordinary skill to implement the Graves et al. teaching in an open postage metering environment in order to allow the user to use an existing printer to print postage.

As per claims 11-13, and 37, Graves et al. teach a device comprising a storage unit for storing an identifier (figure 1- item 170 and figure 4; column 4, lines 1-6; column/line 6/65-7/17). However, Graves et al. do not explicitly recite a corresponding indicia stored on the body of the device. It has been held that printed matter that is not functionally related to an apparatus does not distinguish the claimed apparatus from prior art. Therefore, as Graves et al. teach Applicant's claimed device with a storage identifier (figures 1 and 4), affixing a bar code to the body of said device would have been obvious to one of ordinary skill.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Cordery et al. disclose open postage metering systems

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

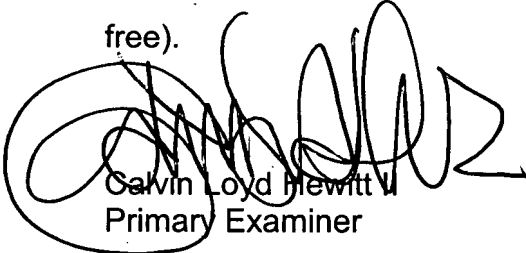
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Calvin Lloyd Hewitt  
Primary Examiner

May 22, 2007